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EXAMINER
HUNTSINGER, PETER K

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments filed 11/3/08 have been fully considered but they are not
persuasive.

The applicant argues on pages 11-13 of the response in essence that:
One of ordinary skill in the art would not find it obvious to utilize a file bundle requiring
multiple applications to open the sub-files of the Sinofsky '178 file bundle.

a.   Sinofsky '178 is relied upon to teach a single file document containing
separate sub-images (col. 3, lines 6-19, compound document that contains sub-
files). At the time of the invention, it would have obvious to a person of ordinary
skill in the art to incorporate multiple files into one comprehensive file. The
motivation for doing so would have been to maintain the integrity of the
comprehensive file (col. 2, lines 16-25).

The applicant argues on page 13 of the response in essence that:
Warmus '149 and Sinofsky '178 do not disclose a rendering device that renders a single
file having sub-images that are rendered as parts of pages of the file.

b.   Warmus '149 discloses a rendering device that renders a single file having
images that are rendered as parts of pages of the file (col. 25, lines 34-46, PDL
master page files 122 and the PDL variable page files 137 and 138 are merged
into PDL file 450 and then provided to the print system 79). Sinofsky '178

discloses a single file containing separate sub-images (col. 3, lines 6-19,

compound document that contains sub-files).

The applicant argues on page 14 of the response in essence that:

Warmus '149 and Sinofsky '178 do not disclose images and sub-images linked within a

single file.

c.   Sinofsky '178 discloses a single file document containing separate sub-

images (col. 3, lines 6-19, compound document that contains sub-files); and

providing links within the file linking one or more pages of the document with one

or more of the sub-images (col. 3, lines 30-34, text file 102 contains link 121 and

122 to other files).

2.   Applicant's arguments with respect to claims 8 and 13 have been considered but

are moot in view of the new ground(s) of rejection.

Response to Amendment

3.   The applicant has not traversed the examiner's assertion of official notice for the

assertions provided in claims 10, 16, 17, 18, 24 and 25. Therefore, the common

knowledge or well-known in the art statement is taken to be admitted prior art

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1-7, 9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Warmus '149 in view of Sinofsky '178 and Simpson '803.

        Referring to **claim 1**, Warmus '149 discloses in an image rendering environment,

a method for dynamically adding one or more document indicia to a document when

rendering the document, the method comprising: providing a rendering job in a native

format that supports at least one of (i) multiple pages, and (ii) multiple images (col. 7,

lines 1-6, page description language);

        storing one or more document indicia (col. 9, lines 57-61, personalized

information, variable image, or the like) as separate sub-images in a native format (col.

7, lines 1-6, variable page files);

        correlating one or more pages of the document with one or more of the sub-

images (col. 7, lines 24-36, master and variable page files merged);

        defining an ordered subset of the sub-images to apply to the document (col. 7,

lines 6-10, press command file specifies the manner in which the master and variable

files are to be merged);

        wherein a rendering device:

        receives the single file in the native format (col. 23, lines 21-35, process the TIFF

file for printing); and

renders the single file, wherein the one or more sub-images are rendered as parts of the one or more pages of the document based on an association process, wherein the association process is one of (i) an overlay process, (ii) an underlay process, and (iii) a composite process (col. 20, lines 1-10, overlay the variable pages on the master pages).

Warmus '149 does not disclose expressly rendering the document without using a printer driver.

Simpson '803 discloses rendering a document without using a printer driver (col. 1, lines 39-51, computer generates a print job without the use of a print driver).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to generate a document without using a printer driver. The motivation for doing so would have been to eliminate the need to specifically configure a computer to make use of many printers.

Warmus '149 does not disclose expressly storing separate sub-images in the single file.

Sinofsky '178 discloses a single file document containing separate sub-images (col. 3, lines 6-19, compound document that contains sub-files); and

providing links within the file linking one or more pages of the document with one or more of the sub-images (col. 3, lines 30-34, text file 102 contains link 121 and 122 to other files).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to incorporate multiple files into one comprehensive file and provide links within

that file. The motivation for doing so would have been to maintain the integrity of the

comprehensive file. Therefore, it would have been obvious to combine Simpson '803

and Sinofsky '178 with Warmus '149 to obtain the invention as specified in claim 1.

Referring to **claim 2**, Warmus '149 discloses wherein the native format is one of:

(i) a tagged image file format; and

(ii) a portable document format (col. 4, lines 21-31, TIFF file).

Referring to **claim 3**, Warmus '149 discloses wherein the document indicia is

disbound from page data of the rendering job (col. 20, lines 1-10, overlay the variable

pages on the master pages).

Referring to **claim 4**, Warmus '149 discloses wherein correlating one or more

pages of the document with one or more of the sub-images comprises a linking the one

or more pages in a next list (col. 7, lines 6-10, press command file specifies the manner

in which the master and variable files are to be merged).

Sinofsky '178 discloses linking one or more pages of the document with one or

more of the sub-images (col. 3, lines 30-34, text file 102 contains link 121 and 122 to

other files).

Referring to **claim 5**, Warmus '149 discloses wherein correlating one or more

pages of the document with one or more of the sub-images comprises a sub-chaining

the one or more sub-images from page images by a sub list (col. 7, lines 6-10, press

command file specifies the manner in which the master and variable files are to be

merged).

Sinofsky '178 discloses linking one or more pages of the document with one or more of the sub-images (col. 3, lines 30-34, text file 102 contains link 121 and 122 to other files).

Referring to **claim 6**, Warmus '149 discloses wherein correlating one or more pages of the document with one or more of the sub-images comprises sub-chaining the one or more sub-images within sub-images (col. 11-12, lines 62-67, 1-22, object inserted defined by curser, user can insert multiple objects).

Sinofsky '178 discloses linking one or more pages of the document with one or more of the sub-images (col. 3, lines 30-34, text file 102 contains link 121 and 122 to other files).

Referring to **claim 7**, Warmus '149 discloses wherein defining an ordered subset of the sub-images comprises creating a set of instructions in one of

(i) a dynamic manner, and

(ii) a static manner (col. 20, lines 49-54).

Referring to **claim 9**, Warmus '149 discloses wherein all the sub-images are in the native format (col. 4, lines 21-31, TIFF file).

Sinofsky '178 discloses a single file document containing separate sub-images (col. 3, lines 6-19, compound document that contains sub-files).

Referring to **claim 11**, Warmus '149 discloses wherein the native format is an image format (col. 4, lines 21-31, TIFF file).

Referring to **claim 12**, Simpson '803 discloses wherein rendering the rendering job occurs within a printing device rendering and printing the document without

rasterization (col. 1, lines 39-51, computer generates a print job without the use of a

print driver).

6.   Claims 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Warmus '149, Simpson '803, and Sinofsky '178 as applied to claim 1 above, and further

in view of Janse '434.

        Referring to **claim 8**, Warmus '149 discloses wherein the one or more sub-

images are placed at one or more locations of the one or more pages of the document

and at one or more scales defined by information, the information being defined

independently of the pages of the document (col. 20, lines 17-23, instruction set

specifying how the pages should be positioned is incorporated into press command file

140).

        Warmus '149 does not disclose expressly storing the location and scale

information within the single document file.

        Janse '434 discloses a single document file containing print setting information

(Fig. 6, col. 7, lines 23-37, TIFF file comprises tear-off part 37 which defines print

settings).

        At the time of the invention, it would have obvious to a person of ordinary skill in

the art to incorporate print setting information into one comprehensive document file.

The motivation for doing so would have been to provide easier methods of handling,

processing and archiving the single file. Therefore, it would have been obvious to

combine Janse '434 with Warmus '149 to obtain the invention as specified in claim 8.

7.   Claim 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Warmus '149, Sinofsky '178, and Simpson '803 as applied to claim 1 above, and further

in view of well known prior art.

        Referring to **claim 10**, Warmus '149 discloses wherein the overlay process

includes applying an overlay on top of one of:

        (i) a page image; and

        (ii) another sub-image (col. 20, lines 1-10, overlay the variable pages on the

master pages).

        Warmus '149 does not disclose expressly applying an underlay process.

        Official Notice is taken that it is well known and obvious in the art to apply an

underlay (See MPEP 2144.03). The motivation for doing so would have been to retain

the information of the master page of the overlapping region as opposed to the variable

page. Therefore it would have been obvious to combine well known prior art with

Warmus '149 to obtain the invention as specified in claim 10.

8.   Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Warmus '149 in view of Simpson '803, Sinofsky '178 and Hayosh '553.

        Referring to **claim 13**, Warmus '149 discloses in a printing environment, a

method for adding document indicia when printing an image, the method comprising:

        using a multi-subfile extension (Fig. 5, col. 11, lines 18-29, file 130 includes file

portions) to represent multiple sub-images of a TIFF image within a single TIFF

document file, wherein data of the TIFF image is not converted into printing instructions

by an application (col. 23, lines 21-23, files 122, 137, and 138 preprocessed to TIFF

format);

using an extension to group and locate the sub-images on a page (Fig. 5, col. 11,

lines 18-29, file 130 includes file portions);

performing at least one of:

supporting an overlay of the multiple sub-images on the page (col. 20, lines 1-10,

overlay the variable pages on the master pages).;

supporting an underlay of the multiple sub-images on the page;

supporting a composite of the multiple sub-images on the page;

specifying a merge order of the multiple sub-images on the page;

specifying a location for merging the multiple sub-images on the page; and

specifying any scaling of the multiple sub-images; and

selectively rendering the TIFF image based on the electronic tags (col. 23, lines

21-35, process the pages for printing).

Warmus '149 does not disclose expressly rendering the document without using

a printer driver.

Simpson '803 discloses rendering a document without using a printer driver (col.

1, lines 39-51, computer generates a print job without the use of a print driver).

At the time of the invention, it would have obvious to a person of ordinary skill in

the art to generate a document without using a printer driver. The motivation for doing

so would have been to eliminate the need to specifically

Warmus '149 does not disclose expressly a single file document containing separate sub-images.

Sinofsky '178 discloses a single file document containing separate sub-images (col. 3, lines 6-19, compound document that contains sub-files).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to incorporate multiple files into one comprehensive file. The motivation for doing so would have been to maintain the integrity of the comprehensive file.

Warmus '149 discloses overlaying images onto a page but does not disclose expressly using electronic tags of a TIFF document file.

Hayosh '553 discloses using electronic tags of a TIFF document file (col. 5, lines 40-48, TIFF tags used to describe the attributes of the image).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to utilize electronic TIFF tags. The motivation for doing so would have been to utilize a standardized programming format to establish print attributes. Therefore, it would have been obvious to combine Sinofsky '178 and Hayosh '553 with Warmus '149 to obtain the invention as specified in claim 13.

Referring to **claim 14**, Warmus '149 discloses wherein the overlay process includes applying an overlay on top of one of:

(i) a page image; and

(ii) another sub-image (col. 20, lines 1-10, overlay the variable pages on the master pages).

Referring to **claim 15**, Warmus '149 discloses specifying both a location for
merging the multiple sub-images on the page and scaling of the multiple sub-images
(col. 20, lines 17-23, instruction set specifying how the pages should be positioned is
incorporated into press command file 140).

Warmus '149 does not disclose expressly specifying the location and scale
information with electronic tags.

Hayosh '553 discloses using electronic tags of a TIFF document file (col. 5, lines
40-48, TIFF tags used to describe the attributes of the image).

At the time of the invention, it would have obvious to a person of ordinary skill in
the art to utilize electronic TIFF tags to specify location and scaling of images. The
motivation for doing so would have been to utilize a standardized programming format
to establish print attributes. Therefore, it would have been obvious to combine Sinofsky
'178 and Hayosh '553 with Warmus '149 to obtain the invention as specified in claim 15.

9.   Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Warmus '149, Simpson '803, Sinofsky '178 and Hayosh '553, as applied to claim 13
above, and further in view of well known prior art.

Referring to **claim 16**, see the rejection of claim 10 above.

Referring to **claim 17**, Warmus '149 discloses adding document indicia to a
document but does not disclose expressly a watermark.

Official Notice is taken that it is well known and obvious in the art to utilize a
watermark when printing a document (See MPEP 2144.03). The motivation for doing

so would have been to protect a document from counterfeit. Therefore it would have been obvious to combine well known prior art with Warmus '149 to obtain the invention as specified in claim 17.

Referring to **claim 18**, see the rejection of claim 10 above.

10.   Claims 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus '149 in view of Sinofsky '178.

Referring to **claim 19**, Warmus '149 discloses a computer readable medium storing a computer program product for implementing within a computer system a method for dynamically adding one or more document indicia to a document when rendering the document, the computer program product comprising computer program code means utilized to implement the method, wherein the computer program code means is comprised of executable code for:

initiating a rendering job of a document as a single file, where the rendering job is in a native format that supports at least one of (i) multiple pages, and (ii) multiple images (col. 7, lines 1-6, page description language);

storing one or more document indicia (col. 9, lines 57-61, personalized information, variable image, or the like) as separate sub-images in a native format (col. 7, lines 1-6, variable page files) along with images representing one or more pages of the document (col. 20, lines 1-10, master pages 122)

correlating one or more pages of the document with one or more of the sub-images (col. 7, lines 24-36, master and variable page files merged);

defining an ordered subset of the sub-images to apply to the document (col. 7, lines 6-10, press command file specifies the manner in which the master and variable files are to be merged); and

using a process to associate the one or more sub-images with one or more of the pages of the document when rendering the document, wherein the process is one of (i) an overlay process, (ii) an underlay process, and (iii) a composite process (col. 20, lines 1-10, overlay the variable pages on the master pages).

Warmus '149 does not disclose expressly a single file document containing separate sub-images.

Sinofsky '178 discloses a single file document containing separate sub-images (col. 3, lines 6-19, compound document that contains sub-files).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to incorporate multiple files into one comprehensive file. The motivation for doing so would have been to maintain the integrity of the comprehensive file. Therefore, it would have been obvious to combine Sinofsky '178 with Warmus '149 to obtain the invention as specified in claim 19.

Referring to **claim 20**, see the rejection of claim 2 above.

Referring to **claim 21**, see the rejection of claim 4 above.

Referring to **claim 22**, see the rejection of claim 7 above.

Referring to **claim 23**, see the rejection of claim 18 above.

11.   Claim 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Warmus '149 and Sinofsky '178 as applied to claim 23 above, and further in view of

Janse '434.

      Referring to **claim 24**, see the rejection of claim 8 above.

12.   Claim 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Warmus '149 and Sinofsky '178 as applied to claim 23 above, and further in view of well

known prior art.

      Referring to **claim 25**, see the rejection of claim 17 above.

Conclusion

13.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

      A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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